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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,244

01/19/2006

Katsuichi Chiba

46449

9167

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MANELLI DENISON & SELTER  
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WASHINGTON, DC 20036-3307

EXAMINER

NGUYEN, KHANH TUAN

ART UNIT

PAPER NUMBER

1751

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,244	<b>Applicant(s)</b> CHIBA ET AL.	
	<b>Examiner</b> Khanh T. Nguyen	<b>Art Unit</b> 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Response to Amendment***

1. The preliminary amendment filed on 03/12/2007 is entered and acknowledged by the Examiner. Claims 1-5 are currently pending in the instant application.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 01/19/2006 and 01/22/2007 has been regarded by Examiner and made of record in the application file.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-5 of copending Application No. 10/565,297. Although the conflicting claims are not identical, they are not patentably distinct from each other because titanium dioxide particles having on their surface a conductive layer comprising tin oxide and the content of a metallic element having a valence of 4 or less which is contained as an impurity in the conductive powder is no more than 0.1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Applicant's definition of "substantially no antimony" is noted on page 13 of the specification.

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Vogt (U.S Pat 6,632,276).

With respect to instant claims 1-5, Vogt discloses a conductive pigment is formed by coating a substrate with a conductive layer, the conductive layer being a tin oxide layer doped with phosphorus (Col. 1, lines 54-57). The substrate can be spherical particles such as titanium dioxide  $\text{TiO}_2$  (Col. 2, lines 22-23). The substrate contains about 25 to 100 weight percent of the conductive layer of tin oxide doped with phosphorus (Col. 2, lines 65-67). The content of phosphorus in the conductive layer, based on the tin, is 0.1-20 atom percent (Col. 3, lines 5-8). The conductive layer may preferably comprise less than 5 weight percent of aluminum oxide, iron oxide, zirconium oxide or chromium oxide to increase the thermal and/or mechanical stability or to produce special color effects. The prior art also discloses the conductive pigments may essentially be free of other oxides or does not contain (0 wt. %) other oxides in the conductive layer (Col. 3, lines 35-50). The Examiner notes that the prior art disclosure inherently reads on the claimed limitation of the impurity content of metallic element in the electroconductive powder is 0.1 or less. The Examiner further notes that the

USPTO is not equipped to perform laboratory testings and experimental benchworks to measure the impurity content of the resulting composition. The burden is on the applicant to prove otherwise.

Furthermore, Vogt discloses the process for forming the conductive pigment by preparing an aqueous substrate suspension and a hydrolysable tin salt solution and an aqueous phosphorus compound are added, the pH of the suspension of the substrate suspension being kept in a range which effects hydrolysis of the tin salt by simultaneous addition of a base or an acid, and the substrate coated in this manner is separated off, washed, dried and calcined at temperature of 400-1100 degrees Celsius with exclusion of oxygen (Col. 1, lines 58-67). The optimum concentration and pH values can be determined by routine experiments. The optimum pH for precipitation is usually retained throughout the entire precipitation process in order to achieve uniform pigments (Col. 3, lines 21-25). The reference specifically or inherently meets each of the claimed limitations. The reference is anticipatory. The burden is upon the applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have been nonetheless obvious to one of ordinary skill in the art, to formulate and process the conductive pigment as claimed, as Vogt discloses the same ingredients (i.e. titanium dioxide substrate coated with tin oxide doped with phosphorus) produce in a similar manner for the same utility.

Nevertheless, the reference is deemed to teach the claimed composition; the applicant or applicants need to show that his, her, or their invention is actually different from and unexpectedly better than the prior art, see *In re Best*, 195 *USPQ* 430, 433,434 (CCPA 1977).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh T. Nguyen whose telephone number is (571) 272-8082. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*lv*

KTN  
Examiner  
05/07/2007

*Douglas McGinty*  
DOUGLAS MCGINTY  
SUPERVISORY PATENT EXAMINER

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